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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,400	03/15/2004	Yukikazu Mori	2271/60883-A	1661

7590 08/31/2006

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EXAMINER
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LEE, TOMMY D

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 08/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/801,400

Applicant(s)

MORI, YUKIKAZU

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,4,6,8,10,12,14,16-18,26-29 and 33-35 is/are allowed.
- 6) ☒ Claim(s) 1,3,5,7,9,11,13,15,19-25,30-32 and 36-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/459,769.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/15/04</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Office action is responsive to applicant's supplemental preliminary amendment filed April 19, 2004. Claims 1-39 are pending.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 09/459,769, filed on December 13, 1999.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims recite a programmed network facsimile device that executes control code, which is functional descriptive material comprising computer programs or algorithms that impart functionality when employed as a computer component. Such

executable code must be embodied on a *computer readable medium* to impart its functionality (see MPEP 2106.IV.B.1(a)).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 37 recites the limitation "the sender address" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 38 depends from claim 37.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 3, 5, 7, 9, 13, 15, 19-21, 23-25 and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,618,749 (Saito et al.) in view of U.S. Patent 6,043,904 (Nickerson).

Regarding claim 1, Saito et al. discloses a network facsimile device connected to the Internet or a local area network, employing an electronic mail function, and having a function of exchanging image information through said Internet or said local area

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network and functions of a facsimile device, comprising: delivery confirmation mail confirming means for detecting, at a time of receiving electronic mail, whether the received electronic mail is an electronic delivery confirmation mail for confirming mail delivery (Internet facsimile and e-mail reception method (note title); delivery status notification mail recognition section judges whether or not received data contains any delivery status notification message (column 8, lines 7-16)).

Saito et al. do not disclose delivery notification partner storing means for storing a mail address of a destination address to which a confirmation is to be delivered, in combination with delivery confirmation mail transferring means for transferring said delivery confirmation mail confirmed by said confirming means to said destination address stored in said delivery notifying partner storing means. However, Nickerson discloses a facsimile apparatus that is capable of providing remote confirmation of job completion (Fig. 7, step 110; Fig. 8, step 124), wherein destination addresses to which a confirmation is to be delivered are stored (Fig. 8, steps 130, 134) and delivery of confirmation mail to the destination addresses is performed (Fig. 7, step 114).

Nickerson recognized that when a user is away from a transmission job originating station, he or she cannot immediately determine whether or not the transmission job was successfully completed, thereby causing delays in correcting potential faults in the transmission job (column 2, lines 15-35). It would have been obvious for one of ordinary skill in the art to modify the teaching of Saito et al., by providing delivery notifying partner storing means and delivery confirmation mail transferring means, such

as taught by Nickerson, so that potential faults in the transmission job can be corrected in a more timely fashion.

Claim 3 further recited determination of whether said confirmation mail includes contents relating to a transferring error. The delivery status notification mail in Saito et al. includes a delivery status notification message indicating that the data received is delivery status notification mail (column 6, lines 14-24). The delivery status notification mail identification section judges the received data (column 6, lines 25-30) and specific information extraction section extracts information on the success/failure of delivery (column 6, lines 31-38).

Claims 5 and 7 each further recite setting means for making valid or invalid said electronic mail transferring operation of said delivery confirmation mail transferring means. Nickerson provides for local confirmation of the transmission job if remote confirmation is not invoked (Fig. 7, steps 110, 112). It would have been obvious for one of ordinary skill in the art to provide means for making valid or invalid the electronic transferring operation so that a user can immediately receive results of the transmission, whether locally or at a remote location.

Claim 9 combines the limitations of above-rejected claims 1 and 3, and further recited means for visibly outputting the contents of said electronic delivery confirmation mail. As mentioned above, Nickerson's facsimile apparatus prints a confirmation page locally (Fig. 7, step 112) or transmits the page to remote destinations (Fig. 7, step 114).

Claims 13 and 15 are method claims corresponding to above apparatus claims 1 and 3, respectively. The combined teachings of Saito et al. and Nickerson suggest the method steps, as set forth above.

Claim 19 is a method claim corresponding to above apparatus claim 9, minus the limitation of transferring electronic delivery confirmation to the destination address when predetermined contents relating to said transferring error are contained in said electronic delivery confirmation mail. Claim 20 further does not recite a limitation for storing a delivery notifying destination mail address. These claims are broader than above-rejected claim 9, and are thus rejected for the reasons set forth above.

Claims 21 and 23 recite a programmed network facsimile device that executes control codes for performing the steps recited in method claims 13 and 15, respectively. The apparatus disclosed in Saito et al. includes a ROM for storing a program executed by the control unit (column 3, lines 53-59). In combination with Nickerson, all of the method steps would have been stored in the ROM.

Regarding claim 24, Saito et al. disclose a network facsimile device connected to a network, comprising: mailer means for transmitting and/or receiving electronic mail through the network, the electronic mail being accompanied by a facsimile image representation (Internet facsimile and e-mail reception method (note title)) and mail detecting means for determining whether a received mail is a delivery notification, upon reception of the received mail (delivery status notification mail recognition section judges whether or not received data contains any delivery status notification message (column 8, lines 7-16)).

While Saito et al. disclose determination of received mail to be a delivery notification, Saito et al. do not disclose memory means for storing a destination address to which a mail delivery notification is to be sent, in combination with mail transferring means for transferring the received mail to said destination address, when the received mail is determined to be a delivery modification. However, as mentioned above regarding claim 1, Nickerson discloses a facsimile apparatus that is capable of providing remote confirmation of job completion (Fig. 7, step 110; Fig. 8, step 124), wherein destination addresses to which a confirmation is to be delivered are stored (Fig. 8, steps 130, 134) and delivery of confirmation mail to the destination addresses is performed (Fig. 7, step 114). Nickerson recognized that when a user is away from a transmission job originating station, he or she cannot immediately determine whether or not the transmission job was successfully completed, thereby causing delays in correcting potential faults in the transmission job (column 2, lines 15-35). It would have been obvious for one of ordinary skill in the art to modify the teaching of Saito et al., by providing delivery notifying partner storing means and delivery confirmation mail transferring means, such as taught by Nickerson, so that potential faults in the transmission job can be corrected in a more timely fashion.

Claim 25 further recites setting means for making valid or invalid said mail transferring operation of said mail transferring means. As mentioned above regarding claims 5 and 7, Nickerson provides for local confirmation of the transmission job if remote confirmation is not invoked (Fig. 7, steps 110, 112). It would have been obvious for one of ordinary skill in the art to provide means for making valid or invalid the



electronic transferring operation so that a user can immediately receive results of the transmission, whether locally or at a remote location.

Claim 36 further recites determining means for determining whether a received delivery notification contains error information which indicates an error occurrence; and outputting means for visibly outputting the contents of delivery notification when the determining means determines that the received delivery notification contains error information. As mentioned above regarding claim 3, the delivery status notification mail in Saito et al. includes a delivery status notification message indicating that the data received is delivery status notification mail (column 6, lines 14-24). The delivery status notification mail identification section judges the received data (column 6, lines 25-30) and specific information extraction section extracts information on the success/failure of delivery (column 6, lines 31-38). Furthermore, the information is output visibly as one page (column 6, lines 27-30; Figs. 7 and 8).

Claim 37 further recites mail transferring means for transferring the received delivery notification to the sender address. As mentioned above regarding claim 1, Nickerson discloses a facsimile apparatus that is capable of providing remote confirmation of job completion (Fig. 7, step 110; Fig. 8, step 124), wherein destination addresses to which a confirmation is to be delivered are stored (Fig. 8, steps 130, 134) and delivery of confirmation mail to the destination addresses is performed (Fig. 7, step 114). Obviously, any destination address capable of receiving electronic mail can be stored in the facsimile apparatus.

Claim 38 further recites setting means for making valid or invalid the transferring operation of said mail transferring means. As mentioned above regarding claims 5 and 7, Nickerson provides for local confirmation of the transmission job if remote confirmation is not invoked (Fig. 7, steps 110, 112). It would have been obvious for one of ordinary skill in the art to provide means for making valid or invalid the electronic transferring operation so that a user can immediately receive results of the transmission, whether locally or at a remote location.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. in view of Nickerson as applied to claim 9 above, and further in view of U.S. Patent 5,134,501 (Satomi et al.).

Claim 11 further recites first setting means for making valid or invalid said electronic mail transferring operation of said delivery confirmation mail processing means; and second setting means for making valid or invalid visible display of said electronic mail of said delivery confirmation mail processing means. Nickerson teaches the first setting means, as mentioned above with respect to claims 5 and 7. The second setting means, while not taught by either Saito et al. or Nickerson, is disclosed in Satomi et al. (in response to depression of a predetermined function key, an error report is prepared only if a communication error takes place (column 3, line 58 – column 4, line 2; column 4, lines 29-41)). It would have been obvious for one of ordinary skill in the art to modify the combined teaching of Saito et al. and Nickerson, by providing second setting means as disclosed in Satomi et al., so as to prevent a waste of recording paper for printing out an error report in the case where no errors are found in the transmission.

12. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. in view of Nickerson and Satomi et al.

Claims 30 and 31 further recite determining means for determining whether a received delivery notification contains error information which indicates an error occurrence; and mail transferring means for transferring the received delivery notification according to the determination result of the determining means, wherein the mail transferring means transfers the received delivery notification to the destination address when the delivery notification contains error information. As mentioned above regarding claim 3, the delivery status notification mail in Saito et al. includes a delivery status notification message indicating that the data received is delivery status notification mail (column 6, lines 14-24). The delivery status notification mail identification section judges the received data (column 6, lines 25-30) and specific information extraction section extracts information on the success/failure of delivery (column 6, lines 31-38). Furthermore, as mentioned regarding claim 1, Nickerson discloses a facsimile apparatus that is capable of providing remote confirmation of job completion (Fig. 7, step 110; Fig. 8, step 124), wherein destination addresses to which a confirmation is to be delivered are stored (Fig. 8, steps 130, 134) and delivery of confirmation mail to the destination addresses is performed (Fig. 7, step 114). Nickerson recognized that when a user is away from a transmission job originating station, he or she cannot immediately determine whether or not the transmission job was successfully completed, thereby causing delays in correcting potential faults in the transmission job (column 2, lines 15-35). It would have been obvious for one of

ordinary skill in the art to modify the teaching of Saito et al., by providing delivery notifying partner storing means and delivery confirmation mail transferring means, such as taught by Nickerson, so that potential faults in the transmission job can be corrected in a more timely fashion.

The transfer of the received delivery notification in Nickerson does not appear to be based on a determination of whether an error has occurred. However, as mentioned above regarding claim 11, Saito et al. disclose selective output of an error report based on whether a transmission error has occurred (in response to depression of a predetermined function key, an error report is prepared only if a communication error takes place (column 3, line 58 – column 4, line 2; column 4, lines 29-41)). In combination with Saito et al. and Nickerson, this teaching would enable selective transfer of an error report to a remote location if a communication error occurs, and such combination would have been obvious to one of ordinary skill in the art, so as to prevent a waste of recording paper for printing out an error report in the case where no errors are found in the transmission.

Claim 32 further recites setting means for making valid or invalid said electronic mail transferring operation of said mail transferring means. As mentioned above regarding claims 5 and 7, Nickerson provides for local confirmation of the transmission job if remote confirmation is not invoked (Fig. 7, steps 110, 112). It would have been obvious for one of ordinary skill in the art to provide means for making valid or invalid the electronic transferring operation so that a user can immediately receive results of the transmission, whether locally or at a remote location.

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13. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. in view of Nickerson as applied to claim 36 above, and further in view of Saito et al.

Claim 39 further recites setting means for making valid or invalid the transferring operation of said mail transferring means. Once again, Nickerson provides for local confirmation of the transmission job if remote confirmation is not invoked (Fig. 7, steps 110, 112). It would have been obvious for one of ordinary skill in the art to provide means for making valid or invalid the electronic transferring operation so that a user can immediately receive results of the transmission, whether locally or at a remote location.

***Allowable Subject Matter***

14. Claims 2, 4, 6, 8, 10, 12, 14, 16-18, 26-29 and 33-35 are allowed.

15. Claim 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

16. The following is a statement of reasons for the indication of allowable subject matter: No prior art has been found to disclose or suggest “transferring said delivery confirmation mail confirmed by said confirming means to a mail address set in a From address field, when a mail address of a sender is set in said From address field of said delivery confirmation mail, and for transferring said delivery confirmation mail to the destination address, when the mail address of the sender individual is not set in said From address field of said electronic mail,” as recited in base claim 2 and similarly recited in base claims 14 and 22; or “transferring said electronic delivery confirmation mail to both said mail address set in said From address field of said electronic delivery confirmation mail and said destination address stored in said delivery notifying partner

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storing means when said delivery confirmation mail includes predetermined contents relating to said transferring error contained in said electronic delivery confirmation mail and when said mail address of the sender is set in the From address field of said electronic delivery confirmation mail; for transferring said electronic delivery confirmation mail to said destination address stored in said delivery notifying partner

storing means when said delivery confirmation mail includes predetermined contents relating to said transferring error contained in said electronic delivery confirmation mail and when said mail address of the sender is not set in the From address field of said electronic mail; for transferring said electrical delivery confirming mail to said mail address set in said From address field of said electronic delivery confirmation mail when said predetermined contents relating to said transferring error not contained in said electronic delivery confirmation mail and when said mail address of the sender is set in the From address field of said electronic delivery confirmation mail; for transferring said electronic delivery confirmation to said destination address stored in said delivery notifying partner

storing means when said predetermined contents relating to said transferring error are not contained in the contents of said electronic delivery confirmation mail and when said mail address of the sender individual is not set in the From address of said electronic delivery confirmation mail," as recited in base claim 4 and similarly recited in base claims 10, 16 and 18; or "confirming, when said received electronic mail is the electronic delivery confirmation mail for confirming the delivery, whether a mail address of a sender is set in a From address field of said electronic delivery confirmation mail; transferring said electronic delivery confirmation mail to said

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stored destination mail address, when mail address of the sender is not set in the From address field of said electronic delivery confirmation mail,” as recited in base claim 17; or “determining means for determining whether a received delivery notification contains a sender address in a From address field; and mail transferring means for transferring the received delivery notification according to the determination result of the determining means,” as recited in base claim 26; or “first determining means for determining whether a received delivery notification contains a sender address in the From address field; second determining means for determining whether the received delivery notification contains error information which indicates an error occurrence; and mail transferring means for transferring the received delivery notification according to the determination result of the first and second determining means,” as recited in base claim 33.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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August 24, 2006